

REMARKS

Claims 1, 4-12, 14, 15, 17, 21 and 24-25 are currently pending in the application. Claims 1 and 15 are currently amended and claims 9, 10 and 17 have been canceled pursuant to this amendment.

Pages 5 and 13 of the specification have been amended to conform the inconsistency in the specification relative to the recitation of beryllium to Table 1 which clearly indicates that the content of beryllium for all of the examples 1-3, 6 and 12 falls between 3-4ppm with 4ppm i.e., 0.004 wt % beryllium the maximum. Accordingly, claim 1 has been further amended to recite 0.0004 wt % as the upper limit of beryllium consistent with Table 1.

The rejection of claims 1, 4-12, 14, 15, 17, 21 and 24-25 under 35 USC 112, first paragraph, as failing to comply with the written description requirement is respectfully traversed. The upper limit of beryllium is now recited in claim 1 to be 0.0004 wt % which is clearly supported in Table 1 of the specification. Claims 9, 10 and 17 have been canceled. Claim 15 has been amended to conform the minimum creep rate to the value set forth in Table 4.

Accordingly, claims 1, 4-8, 11, 12, 14, 15, 21 and 24-25 as now amended clearly comply with the written description requirement under 35 USC 112 and the rejection should be withdrawn.

Applicant has submitted herewith a Terminal Disclaimer in compliance with 37 CFR 1.321 to overcome the non-statutory double patenting rejection of claims 1, 4-8, 11, 14-15, 21, 24 and 25.

The rejection of claims 1, 4-6, 11-12, 14, 15, 17, 21 and 24-25 under 35 USC 102(e) as being clearly anticipated by U.S. 2001/0023720 to Ohori, et al is respectfully traversed. Claim 17 has been canceled. Claim 1 has been amended to limit the alloy content of beryllium to a maximum of 0.000 wt %. In addition, the aluminum range is now limited to 6.1 to 9.2 wt % which is clearly supported by the data in Tables 1, 3 and 4. This range clearly falls outside the range identified in Ohori, et al. An accompanying Declaration of applicant under 35 USC 132 is attached hereto explaining the subject invention and the distinction between the subject invention and the cited references. It should further be

pointed out that the alloy of the present invention results in an acceptable creep rate which cannot be achieved by Ohori, et al. In addition, document US 2001/0023720 teaches a die casting alloy having an aluminum content of preferably less than 5 wt % and no more than 6 wt % as is set forth in Tables 1 and 2.

For all of the above reasons, the rejection of claims 1, 4-6, 11-12, 14, 15, 21 and 24-25 under 35 USC 102(e) should be withdrawn.

The rejection of claims 1, 4-11, 13-25 under 35 USC 102(e) as being clearly anticipated by US Patent 6,139,651 to Bronfin, et al is respectfully traversed.

The accompanying Declaration of the applicant is intended to clarify the subject invention and to distinguish it from all of the cited references. It should however be noted that the amendment to claim 1 limiting the upper limit of beryllium to 4 wt % is of itself sufficient to distinguish the subject invention from Bronfin, et al under 35 USC 102(e).

In addition, Bronfin, et al teaches alloys with low Sr content exemplified by 0.12 or less wt % and high Be content of up to 15ppm exemplified by 7-11ppm (see Table 1 in Bronfin, et al) whereas the subject application teaches a higher content of Sr and a maximum content of Be of 4ppm. Accordingly, the rejection of claims 1, 4-11 and 13-25 under 35 USC 102(e) should be withdrawn.

The rejection of claims 1, 4-6, 11-12, 14, 15, 17, 21 and 24-25 under 35 USC 103 as being unpatentable over US Patent 6,342,180 to Lefebvre, et al (hereafter US '180).

As explained in the accompanying Declaration of the applicant, Lefebvre broadly claims nearly all practical combination of elements but does not teach how to selectively restrict the alloys to achieve an acceptable creep rate. It should be understood that to one skilled in the art even minor differences between alloy compositions are understood to contribute to significantly different behavior of the mixtures. Accordingly, not only is there no motivation to modify the broad composition taught in Lefebvre but without the application, a skilled person would not know how to formulate well castable alloy compositions which will possess low creep rates as is taught in the subject application. Moreover, Lefebvre at line 44 of column 2, teaches limiting the aluminum content to between 4.5-5.5 wt % which teaches away from the aluminum range as claimed in claim 1 of the

subject application. The Examiner has not provided any meaningful explanation to support the naked allegation that it would be obvious to select a desired range from the whole range of possible combinations of concentrations taught in Lefebvre. Accordingly, based upon the accompanying Declaration and the aforementioned remarks, the rejection of the claims 1, 4-6, 11-12, 14, 15, 21 and 24-25 under 35 USC 103 should be withdrawn.

The rejections of the claims under 35 USC 103 based upon EP 1127950 and JP 06200348 is also respectfully traversed.

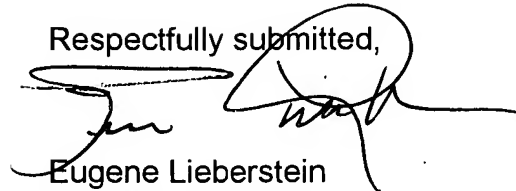
The Examiner's attention is drawn to the fact that the European Patent (referred to as "EP/50") is the same as the recited reference Ohori US 2001/0023720. The applications are nearly identical and therefore the comments raised earlier with regard to Ohori US 2001/0023720 apply to this rejection.

With regard to JP 06200348, it is pointed out in the attached Declaration of applicant that the JP document does not differentiate between alloys i.e. solid solutions and multi-phase heterogeneous systems such as solid dispersions. Moreover, since the JP document covers mixtures that are known in the science of metallurgy as being incompatible with solid solutions to which the subject application applies, it is not possible for the Examiner to draw an analogous argument based on obviousness. Accordingly, no basis exists for combining JP 06200348 with EP 1127950.

In view of the amendment to the claims and in view of the accompanying Declaration of applicant, the instant application is clearly non-obvious over the cited documents. The composition of the claimed alloy is characterized by superior castability combined with a good creep rate.

Reconsideration and allowance of claims 1, 4-8, 11-12, 14, 15, 21 and 24-25 is respectfully solicited.

Respectfully submitted,

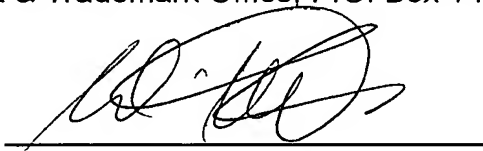


Eugene Lieberstein
Reg. No. 24,645

ANDERSON, KILL & OLICK
1251 Avenue of the Americas
New York, New York 10020-1182
(212) 278-1000

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, United States Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on **January 10, 2005**.



Date: Jan. 10, 2005